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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,894	10/23/2003	Mike E. Little	5681-33700	8981

35690   7590   04/03/2007
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EXAMINER
WILSON, YOLANDA L

ART UNIT	PAPER NUMBER
2113	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/691,894	LITTLE ET AL.
	Examiner	Art Unit	
	Yolanda L. Wilson	2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 December 2006</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6 and 43-79* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-3,43,47-50,52,54,57-61,63,65,68-70,75,76 and 79* is/are rejected.
7)☒ Claim(s) *4,6,44-46,51,53,55,56,62,64,66,67,71-74,77 and 78* is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>02/12/07</u>
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims are rejected under 35 U.S.C. 102(e) as being anticipated by McCaleb et

al. (USPN 6170065B1). As appears in claim 1, McCaleb et al. discloses a processor; a

memory coupled to the processor and configured to store program instructions

executable by the processor to implement in column 3, lines 16-19: a knowledge

automation engine in column 3, lines 43-44 comprising: a knowledge interface to

receive one or more checks and one or more corresponding product check matrixes

from a knowledge repository, wherein the one or more of packages or patches

applicable to one or more product issues in column 7, lines 23-31 (the patch worker); a

fact interface to receive one or more facts describing a product configuration in column

7, lines 27-28 (patch checker); wherein the knowledge automation engine automatically

evaluates a rule in the one or more checks against the one or more facts to determine if

the one or more product issues specified by the one or more checks exists for the

product configuration in column 7, lines 28-31; and wherein if the one or more product

issues are detected, the knowledge automation engine applies one or more of packages

or patches specified in the one or more corresponding product check matrixes to correct the one or more product issues in column 7, lines 19-31. The Product check matrixes is the part database (see column 3, lines 64-67).

3.   As per claim 2, McCaleb et al. discloses wherein the one or more product check matrixes comprises: a package and a patch associated with the package in column 3, lines 64-67. The package is the name of the software. The patch is the updated software version.

4.   As per claim 3, McCaleb et al. discloses wherein the association between the package and the patch is predefined in column 3, lines 64-67.

5.   As per claim 43, McCaleb et al. discloses wherein a product check matrix of the one or more product check matrixes specifies one or more of packages or patches directly applicable to a specific product issue detectable by executing the rule of a check associated with the corresponding product check matrixes in column 7, lines 19-31.

6.   As per claim 47, McCaleb et al. discloses wherein a product check matrix of the one or more product check matrixes specifies a patch for a specific product issue of the one or more product issues and wherein the product check matrix of the one or more product check matrixes corresponds to a specific check of the one or more checks; wherein the specific check of the one or more checks comprises a rule to detect the specific; and wherein upon detecting the specific product issue, the specified patch, for the specific product issue, from the corresponding product check matrix is applied to correct the specific product issue in column 7, lines 19-31. To correct problems for specific software is what the part database contains.

7.   As per claims 48,59, McCaleb et al. discloses listing one or more of packages or

patched in a product check matrix, wherein the product check matrix corresponds to

one or more product issues in column 3, lines 64-67; defining one or more check

elements related to the one or more product issues, wherein the one or more check

elements are linked to the corresponding product check matrix with the one or more of

packages or patches for correcting the one or more product issues; and evaluating the

rule against a fact to determine if the one or more product issues is present on a

product in column 7, lines 19-31; column 3, lines 64-67. The rule is the comparison of

client software info to the updated software in the part database.

8.   As per claims 49,60 McCaleb et al. discloses retrieving the fact from a fact

repository about the product in column 7, lines 19-31; column 3, lines 64-67.

9.   As per claims 50,61, McCaleb et al. discloses applying the one or more of the

packages or patches to the product specified in the corresponding product check matrix

when the one or more product issues are discovered by evaluating the rule in column

7, lines 19-31.

10.   As per claims 52,63, McCaleb et al. discloses wherein the one or more of

packages or patches listed by the product check matrix includes at least a package and

a patch associated with the package; and wherein the method further comprises

defining one or more associations between the package in the product check matrix and

the patch in column 3, lines 64-67.

11.   As per claims 54,65, McCaleb et al. discloses wherein the one or more of

packages or patches listed by the product check matrix includes at least a package and

a patch associated with the package; wherein the method further comprises defining

one or more associations between the package and the patch in the product check

matrix; and wherein the one or more associations are defined according to patch

updated applied to the package in a database accessible by a knowledge automation

engine in column 7, lines 19-31.

12.   As per claims 57,68, McCaleb et al. discloses wherein the one or more check

elements are used with the corresponding product check matrix in column 7, lines 19-

31.

13.   As per claims 58,69, McCaleb et al. discloses wherein the one or more check

elements are selected from the rule, a problem statement, or a link to reference

documentation in column 7, lines 19-31. The rule is the comparison. The rule is the

comparison of client software info to the updated software in the part database.

14.   As per claims 70, 76, McCaleb et al. discloses receiving a check from a

knowledge repository, wherein the check comprises a rule for detecting a specific

product issue; receiving a fact describing a product configuration; evaluating the rule

against the fact to determine if the specific product issue exists for the product

configuration; and applying a package listed in a product check matrix to correct the

specific product issue, wherein the product check matrix is associated with the check

and the specific product issue and is selectively accessed to determine a package to

use to correct the specific product issue in column 7, lines 19-31 and column 3, lines

64-67.

15.   As per claims 75,79, McCaleb et al. disclose receiving the corresponding product

check matrix with the check in column 7, lines 19-31.

Double Patenting

16.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
       Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

17.   Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claim 1 of copending Application No.

10/318707. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the product check matrixes are the facts describing a

product configuration associated with the patches and packages used to correct the

product issues that represent the remediation information disclosed in claim 1 of '707;

therefore, it would be obvious to have the product check matrixes in '707 because of

this rationale.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

18.   Applicant's arguments with respect to the rejection(s) of claim(s) 1-4,6 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of McCaleb et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yolanda L. Wilson whose telephone number is (571) 272-3653. The examiner can normally be reached on M-F (7:30-4:00).
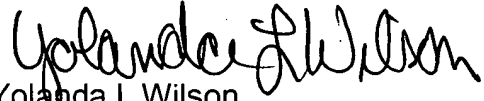
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571) 272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yolanda L Wilson
Examiner
Art Unit 2113